

### REMARKS

The comments of the applicant below are each preceded by related comments of the examiner (in small, bold type).

#### *Election/Restrictions*

**3. Newly submitted claims 55-58 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Regarding independent claim 55, it claimed concept "automatically identifying, in a first portion of the captured handwriting, instructions pertaining to a second portion of the captured handwriting, and communicating at least the second portion of the captured handwriting to a remote server over the communication network." is distinct from the invention originally claimed because original independent claims do not claim this distinctive concept.**

**Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 55-58 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.**

Claims 55-58 have been cancelled.

**5. Claims 1-2, 4-10, 12-13, and 38-54 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Regarding independent claims 1, 12, and 49, nowhere in the original disclosure of the specification show the support for the amended concept "the data representing the handwriting motion and are *communicated to the server through a communication device separate from the handwriting-capturing device without the user operating the communication device*" (emphasis added) or limitations that are claiming substantially similar to this concept. Referring to claim 13, there is not support in the specification found for the limitation "providing an interactive user interface on a mobile device *independent of the handwriting-capturing device to enable a user of the handwriting-capturing device ... stored handwriting information*" (emphasis added). When consider the specification, page 2, lines 19-24 and page 3, lines 1-5, seems to suggest that user is taking part in controlling the function of communication.**

**Regarding claims 52 and 54, there is now support found to disclose the handwriting capturing device is a pen holder used in combination with a pen.**

**The Applicant is required to show exact location (page number and line number) regarding the description requirements above.**

**Other claims are rejection because of their dependency to the independent claims.**

The communication device and handwriting-capturing device being separate is supported by at least figure 1 and page 10, line 15, through the first line of page 11: "the pen can connect through a serial or infrared interface 52 of the cellular phone" and "in implementations in which

the tracker is not part of or attached to the phone, the pen 12 has a beaming capability that enables it to convey the handwriting data to the cell phone.”

Support for the mobile device with the user interface being separate from the handwriting-capturing device is found, for example, at page 16, lines 2-4: “The compressed data is stored in the pen’s local memory until the pen is connected to a cell phone.” The specification notes at page 12, line 6, that functions can be performed “at the cell phone.” The user interface described from page 16, line 19 to page 24, line 33, is clearly implemented on a phone separately from the handwriting-capturing features of the pen.

Regarding claims 52 and 54, the specification states at page 7, lines 10-11, for example, that “the tracking device can be housed in a cap of the pen [or] in a pen well.”

**7. Claims 1-2,4-10,12-13, 38-51 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Yamakita, Tooru EP 0 865 192 and Morishita et al. U.S. Patent No. 6,335,727, and further in view Lee U.S. Patent No. 5,347,477.**

**Regarding claim 1, Yamakita teaches a method comprising:**

**Receiving handwriting data (writing data on portable terminal) electronically from a remote user at a handwritten-information server (host device) (page 1, column 1), and Processing the handwriting data in accordance with instructions provided to the server by the user (page 1, column 2). However, Yamakita does not explicitly teach the receiving of handwritten-information data on a pen which the data comprise coordinate points. Morishita further teaches a handwriting recognition method further comprises the method of receiving handwritten-information which the data comprises coordinate points representing the handwriting motion (FIG. 5, element 12; FIG. 9, element 12; FIG. 8). Modifying Yamakita's method of processing handwriting according to Morishita would have been obvious for one skilled in the art to use a pen to capture data on a pen wherein data comprise coordinate points representing the handwriting motion. This would improve processing so that handwriting information can be provided with high portability (column 4, lines 1-5) and therefore, it would have been obvious to one of the ordinary skill in the art to modify Yamakita according to Morishita.**

The above references to Morishita are not relevant to the amended wording of claim 1 as presented in the applicant’s previous reply.

**Yamakita also illustrates the handwriting data of handwriting motion are communicated to the server through a communication device separate from the handwriting-capturing device (communication of information by infrared ray) (column 5, lines 3-24). Lee further teaches a method of processing handwriting information (column 8, line 50) wherein discloses a communication between the handwriting-capturing device to the server separate from the handwriting-capturing device without the user operating the communication device (the ability to provide user to communicate/operate information storing on a computer without learning about the operating commands/file names/file types**

thus is without the user operating the communication device. In this case, the communication devices are communicating among themselves independently) (abstract, first 10 lines; column 7, lines 20-25 and 45-60).

Modifying Yamakita's method of processing handwriting according Lee to would have been obvious for one skilled in the art to implement a communication between the handwriting-capturing device to the server separate from the handwriting-capturing device without the user operating the communication device. This would improve processing because it help operators who lacks the knowledge of computer can still operate the system efficiently (column 7, lines 55-60) and therefore, it would have been obvious to one of the ordinary skill in the art to modify Yamakita according to Lee.

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2. Applicant's arguments with regard to claims 1 and 13 have been fully considered, but are not considered persuasive because of the following reasons:

Regarding claims 1 and 13, the Applicant argues (pages 7-8 of the Remarks) that none of Yamakita, Morishita, or Le describe a concept of providing an interface on a device, independent of the device which captured the handwriting or without the user operating the communication device. The Examiner respectfully disagrees. Lee U.S. Patent No. 5,347,477 teaches a communication between the handwriting-capturing device to the server separate from the handwriting-capturing device without the user operating the communication device (the ability to provide user to communicate/operate information storing on a computer without learning about the operating commands/file names/file types thus is without the user operating the communication device. In this case, the communication devices are communicating among themselves independently separate from user) (abstract, first 10 lines; column 7, lines 20-25 and 45-60).

Thus, the rejections of all of the claims are maintained.

Claim 1 has been amended. Yamakita does not describe and would not have made obvious that the handwriting-capturing device that captured the handwriting data is "*separate from the mobile communication device*" at which the handwriting data is received (emphasis added). To the contrary, although in Yamakita, the communication function may be implemented using a radio channel to a "nearby base station" or an IR connection to an unidentified device (col. 5, lines 20-28), the fact remains that the portable terminal is the only mobile communication device described, and that device includes the handwriting-capturing capabilities.

With regard to Lee, the examiner appears to have conflated parts of claims 1 and 13, but in any case, Lee does not describe and would not have made obvious the features of either claim. Lee mentions that the user can "*operate*" the form computer "*without learning* commands, file names, file types, and other details" (abstract, emphasis added) and that a user who "lacks the knowledge of computer science *can still operate*" the computer (col. 7, lines 55-57, emphasis added). But Lee says nothing about receiving data captured on "*a handwriting-capturing device separate from the mobile communication device*" (claim 1, emphasis added). There simply is no

separate handwriting-capture device in Lee. Lee also says nothing about providing an interface on a mobile device that receives handwriting information “from a *separate* handwriting-capturing device” (claim 13, emphasis added). Whether or not the user described in Lee can use a device without knowing how it works is irrelevant to whether the handwriting-capturing and communication devices are *separate*.

**For claim 6, Yamakita teaches the method of including the location of the remote user, forming an electronic file representing the handwritten information (column 1, lines 13-17), and transmitting the electronically captured handwriting from the communication device to the handwritten-information server (page 1, column 1 and column 2). Yamakita does not explicitly teach wherein the pen can be electronic wireless pen. Lee further teaches a method processes handwriting wherein handwriting data is generated by an electronic wireless communication device (wireless pen) (column 3, lines 24-25 and FIG. 5). Modifying Yamakita's method of processing handwriting data according to Lee would able to provide a wireless pen in providing the wireless capability for the apparatus. This would improve processing and therefore, it would have been obvious to one of the ordinary skill in the art to modify Yamakita according to Lee.**

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**For claim 12, please refer back to claim 1 for discussed limitations and claim 6 for the teaching of wireless communication. In addition, Yamakita teaches the concept of storing (computer) (page 2, column 1, line 30).**

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**Regarding claim 49, please refer back to claims 1 and 6 for further teachings and explanations. In addition, Yamakita teaches processing the handwriting data represented by the file in accordance with instructions provided to the server by the user (column 8, lines 25-30 and column 16, lines 31-37).**

Claims 12 and 49 have been amended and are patentable for at least similar reasons as claim 1.

**Referring to claim 13, please refer back to claims 1 for the discussed limitations and claims 6 and 12 for the teaching of wireless communication. Furthermore, Yamakita teaches a method providing an interactive user interface on a screen of a mobile device to enable a user to control functions (commands) applied (page 7, column 11, lines 39-47) to the stored handwriting information (simple interface) (page 2, column 2, lines 40-45).**

Yamakita describes a user interface that is integrated with the digitizer: “a locus pattern pressed on the LCD display unit 11 by the pen input is overwritten in the memory ... the image data currently displayed on the LCD display unit 11 is stored ... a screen for causing the user to specify [what to do with the image] is displayed on the LCD display unit 11” (p. 7, col. 11, lines 36-47). This configuration described in Yamakita does not describe and would not have made

obvious “providing an interactive user interface on [a] mobile device” that receives handwriting information “from a *separate handwriting-capturing device*.”

Lee describes a touch panel integrated into a single electronic device: “The pen 24 *does not comprise any electronic components*. Any object can be used to cause reaction of the *touch panel* (as indicated at 8 in FIG. 2) by giving it a pressure” (col. 3, line 67 – col. 4, line 4, emphasis added). Lee does not describe and would not have made obvious using a mobile device that receives handwriting information “from a separate handwriting-capturing device” (claim 1) let alone providing a user interface on one (claim 13).

The devices in each of Yamakita, Morishita, and Lee integrate handwriting into a single portable device—none describes or would have made obvious receiving handwriting information from a handwriting-capturing device at a separate mobile device.

Claims 12 and 49 have been amended and are patentable for at least similar reasons as claims 1 and 13. All of the dependent claims are patentable for at least the reasons for which the claims on which they depend are patentable.

Canceled claims, if any, have been canceled without prejudice or disclaimer.

Any circumstance in which the applicant has (a) addressed certain comments of the examiner does not mean that the applicant concedes other comments of the examiner, (b) made arguments for the patentability of some claims does not mean that there are not other good reasons for patentability of those claims and other claims, or (c) amended or canceled a claim does not mean that the applicant concedes any of the examiner's positions with respect to that claim or other claims.


Applicant : Ilya Schiller et al.  
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Attorney's Docket No.: 19965-004001

Enclosed is the check of \$510.00 for the Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050, referencing 19965-004001.

Respectfully submitted,

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Misha K. Hill  
Reg. No. 59,737

Fish & Richardson P.C.  
225 Franklin Street  
Boston, MA 02110  
Telephone: (617) 542-5070  
Facsimile: (617) 542-8906

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